

REMARKS

In the Office Action dated August 20, 2009, Claims 1-22 were rejected. By this paper, Applicant has amended Claims 1, 7, 9, 18, and 21, canceled Claims 16 and 22, and added Claims 23-25. The amendments to Claims 1, 7, 9, 18, and 21 are supported at least by Figures 2-4 of the originally filed specification. The new claims are supported at least by Figures 1 and 7 of the originally filed specification. Applicant respectfully requests reconsideration of the application in view of the amendments set forth above and the remarks set forth below.

Discussion of the Objections to the Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. In particular, the Office Action stated “the combination of the stripping element with a non-circular cross-section, a guide element with a substantially similar cross-section (claim 1) and at least one guide bushing within the stripping element (claim 16) must be shown or the feature(s) cancelled from the claim(s).” Applicant has canceled Claim 16 rendering the objection moot.

Discussion of the Objections to the Claims

Claims 7, 9, 18, and 21 were objected to for certain informalities. Applicant has amended the claims according to the Examiner’s suggestions.

Discussion of the Rejection under 35 U.S.C. § 112, First Paragraph

Claim 16 was rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Applicant has canceled Claim 16 rendering the rejection moot.

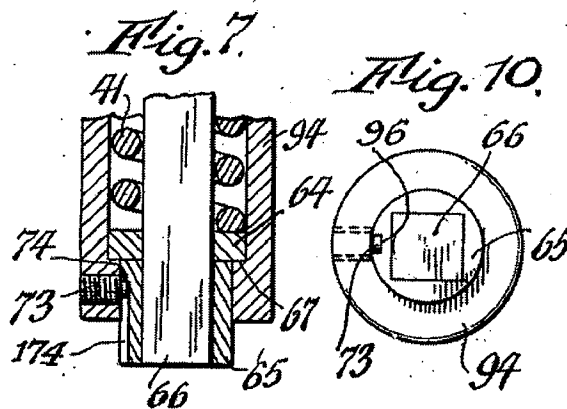
Discussion of Rejection under 35 U.S.C. § 102(b)

In the Office Action, Claims 1, 3-5, 7, 9, 11, 12, 14-18, and 17-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by Wales (U.S. Patent No. 2,168,377). Applicant respectfully submits that, as stated in the M.P.E.P. at § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described,

in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). Further, the elements must be “arranged and combined as required by the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008). Applicant further submits that the cited references fail to describe at least one feature of independent Claim 1.

Claim 1, as amended, recites “a guide element having an inner surface defining a hole with a non-circular cross-section corresponding in shape with the non-circular cross-section of the stripping element, the entire surface of the hole being formed by a single homogeneous piece of material.” Applicant respectfully submits that Wales does not disclose such a feature.

The Office Action sets forth remarks that the combination of the “punch holder 94” and “set screw 96” of Wales, as shown below, define a shape which is “substantially similar to the cross-section of the stripping element.” Applicant respectfully submits that the “punch holder 94” and “set screw 96” do not define a hole in which the entire surface is formed “by a single homogeneous piece of material” as recited in Claim 1.



Because Wales does not disclose “a guide element having an inner surface defining a hole with a non-circular cross-section corresponding in shape with the non-circular cross-section of the stripping element, the entire surface of the hole being formed by a single piece of homogenous material” as recited in Claim 1, Applicant respectfully submits that Claim 1 is not anticipated by Wales. Claims 3-5, 7, 9, 12, 14-15, and 17-22 depend from Claim 1 and further define additional technical features of the present invention. In view of the patentability of their base claim, and in further view of their additional technical features, Applicant respectfully

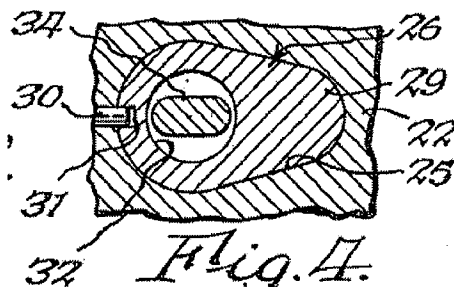
submits that the dependent claims are likewise not anticipated by Wales. Accordingly, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b).

Discussion of Rejection under 35 U.S.C. § 103(a)

Claims 1, 2, 7-8 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wales in view of Taylor (U.S. Patent No. 2,760,574). Applicant further submits that, as stated in the M.P.E.P. at § 2143, "The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1395.

As mentioned above, Claims 1 recites "a guide element having an inner surface defining a hole with a non-circular cross-section corresponding in shape with the non-circular cross-section of the stripping element, the entire surface of the hole being formed by a single piece of homogenous material." As also mentioned above, Wales fails to disclose this feature.

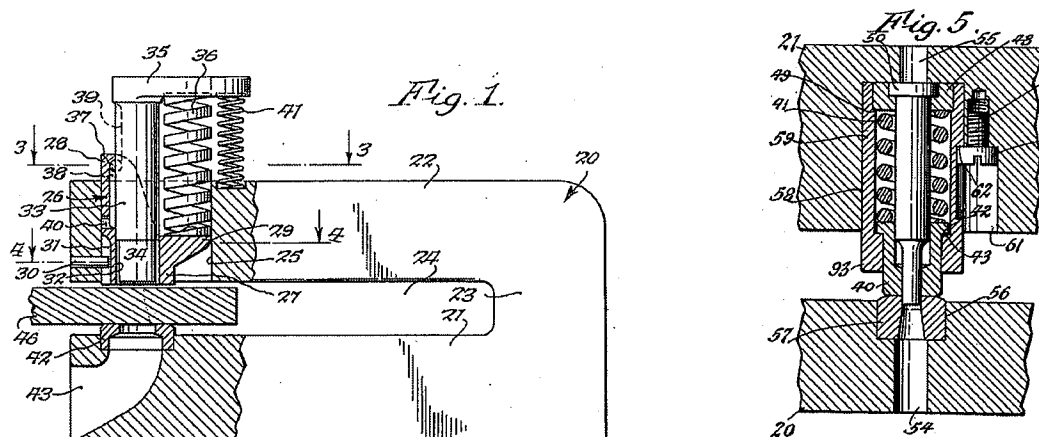
Taylor, at Figure 4 reproduced below, shows a similar configuration to that of Wales, in which a "pin 30 having an inner end which extends into a vertical slot 31 in the element 26." Taylor at c. 3, ll. 17-19. Applicant again respectfully submits that the "arm 22" and "pin 30" do not define a hole in which the entire surface is formed "by a single homogenous piece of material" as recited in Claim 1.



The Office Action stated that it "would have been obvious to one having ordinary skill in the art to have similarly incorporated a non-circular stripping element in the Wales device as taught by Taylor as an additional well known means to prevent the rotating of the Wales stripping element." See pg. 11. Applicant respectfully disagrees that a skilled artisan would have any motivation to modify Wales in the manner stated in the Office Action.

As can be seen in Figure 1 of Taylor, the device of Taylor is provided with a non-circular cross-section not to prevent rotation, but to provide the stripper with a lateral extension 29 for supporting the lateral stripper spring 36. In contrast, as can be seen in Figure 5 of Wales, the device includes a stripper spring 41 arranged around the punch. Similarly, Claim 1, as amended, recites "a spring-elastic element which is arranged outside the workpiece contact region and around the cutting element." Therefore, a lateral extension is unnecessary and would result in an irregular shaped spring thereby further adding to the cost of the device.

The Office Action has stated that the motivation to incorporate a non-circular stripping element is to add "an additional well known means to prevent the rotating of the Wales stripping element." Applicant respectfully disagrees that one of ordinary skill in the art would modify a device to include an unnecessary and redundant anti-rotation mechanism where the device of Wales is already designed with a stop 73, 74 for such a purpose.



In view of the above, Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to the pending claims and Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Discussion of New Claims

Claims 23-25 depends on Claim 1, which is allowable for the reasons set forth above. In view of the patentability of its base claim, and in further view of its additional technical features, Applicant respectfully submits that Claims 23-25 are patentable over the prior art of record.

Application No.: 10/522,078
Filing Date: July 5, 2005

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims, and that those claims are in condition for allowance. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve any such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: November 19, 2009

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